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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/790,111	03/02/2004	Hiroataka Tanaka	Q80222	1148

23373 7590 08/11/2005

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EXAMINER

WILSON, LEE D

ART UNIT	PAPER NUMBER
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3723

DATE MAILED: 08/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Taka

Office Action Summary	Application No. 10/790,111	Applicant(s) TANAKA ET AL.	
	Examiner LEE D. WILSON	Art Unit 3723	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/20/04</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. The following claims are vague, indefinite, awkwardly, and confusingly worded:

- i. Claims 1-7 should recite method steps. The applicant should state the "comprising steps of the method:" or comprising the method having steps of:" . The applicant just needs to incorporate the idea that the method has steps.
- ii. Claim 6 is indefinite because what is claim 1. These steps should positively recited or written so that claim 1 steps are clearly further limited by the steps of claim 6.
- iii. Claim 7 is vague because this the method is method of production and then it appears that the claim is trying to claim the end product to be used in a use aside from the production steps. Is the applicant claiming the steps of producing the substate or the step of using the end product of the production method. It seems that the method of production is not further limited by the use of the end product and therefore does not properly limit the claim. The intended use of the chip would be left to those who purchase the chip for whatever process they wish to install it.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 3, and 5-7 are rejected as best understood under 35 U.S.C. 102(e) as being anticipated by Shimada (6632547).

Shimada teaches a method comprising the steps of polishing glass substrate (col.1, 53-55 and fig.2a), a treating liquid (col.3, line 55 and col.5, 47-55 which shows a liquid having colloidal particles), a tape (col.5, 47-53), and a chemical strengthening (col.4, 45-65 and throughout the patent there are numerous other mentions.).

4. Claims 1-7 are rejected as best understood under 35 U.S.C. 102(e) as being anticipated by Saito et al (2003/0110803A1).

Saito et al teach a method comprising the steps of polishing glass substrate (abstract), a treating liquid (40 and a liquid having colloidal particles), a treating liquid (pure water par.98), a tape (30), and a chemical strengthening (abstract and throughout the patent there are numerous other mentions.).

5. Claims 1-4 and 6-7 are rejected as best understood under 35 U.S.C. 102(b) as being anticipated by Marukawa (6315638).

Marukawa teaches a method comprising the steps of polishing glass substrate (abstract), a treating liquid (slurry col.4, 31), a treating liquid (pure water col.4, 55-60), and a tape (T).

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Yamada and Okuyama et al disclose an invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LEE D. WILSON whose telephone number is 571-272-4499. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JOSEPH HAIL can be reached on 571-272-4485. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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A handwritten signature in black ink, appearing to read 'Lee D. Wilson', written in a cursive style.

Ldw

August 8, 2005

LEE D. WILSON
PRIMARY EXAMINER